

**Termination of Exclusive Rights to Trademarks in the European Union  
(Comparison with the Legislation of the Republic of Uzbekistan)****Zafar Babakulov**Doctor of philosophy in legal sciences (Ph.D.), Doctoral student of Tashkent State Law University  
(DSc)**Abstract**

the article is devoted to the termination of legal protection of a trademark in the countries of the European Union. Development of economic relations between Uzbekistan by the European Union, the main foreign trade partner, makes the necessary harmonization of their legal systems, including in the sphere of trademarks. In the article, a provisional analysis of the provisions of trademarks on trademarks of a number of countries of the European Union. The similarity and distinction of these laws in the above sector with the Civil Code of the Republic of Uzbekistan are revealed.

**Keywords:** trade mark, extension, expiration, registration, termination, exclusive rights, EU, Czech Republic, Finland, Uzbekistan, Denmark, Civil Code, Spanish.

A very important point of the legal protection of a trademark and the right to a trademark is the issue of termination of the legal protection of the trademark. The legislation of the European Union countries contain a number of grounds for the termination of the legal protection of the trademark.

Termination of the legal protection of a trademark in connection with the expiration of the exclusive right to a trademark is provided for in certain countries of the European Union. In the Czech Republic, the timing of the trademark is terminated if the timing of the trademark is ends, and the request to extend the period was not filed on time<sup>1</sup>. Austria's law on trademarks indicates that the trademark is invalid if the trademark owner has not been submitted to the extension of the registration of a trademark<sup>2</sup>. In Finland, the extension of the registration period cannot be produced earlier than 1 year before its expiration or later than 6 months after the expiration. At the same time, registration will be considered extended by the fact of payment of the relevant duty. If the holder exclusive rights to the trademark does not submit an application for renewal of the registration period and the corresponding fee is not paid, then the trademark is excluded from the register<sup>3</sup>. In Ireland, the Patent Office (Auditor) is entrusted to inform the right holder of the registered trademark on the date of calculation of the duration of the registration of the trademark and the procedure for its extension before the expiration of such a term<sup>4</sup>.

In general, it should be noted that the procedures for extending the validity of trademark registration in the countries of the European Union are similar to those in Uzbekistan. The extension of the validity period of the trademark registration is made on the basis of an application

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<sup>1</sup> Czech Republic, Law on Trademarks (Article 24 (1) (№137 of June 21,1995)// Industrial Property and Copyright. 1996. -4.-3-001.

<sup>2</sup> Austria, Trademark Protection Law (Article 29 (1) (Federal Law of 1970, as last amended by the Law of March 7, 1984, amending the Patent Law and the Trademark Protection Law)// Industrial Property. – 1982/11/-3-001.

<sup>3</sup> Finland, Trademarks Act №7 on January 10,1964 (Article 22-24) (as amended by Act №1715 of December 22,1995//Intellectual Property Laws and Treaties. -1998/4.-3-002.

<sup>4</sup> Ireland Trade Marks Act 1996 (Article 24 (1) (Act No. 6 of 1996). wipolex.wipo.int/en/legislation/details/2332

for the extension of this period submitted by the trademark owner. In some countries (for example, in Finland), the extension of the registration period, as mentioned, is possible automatically if the corresponding fee is paid.

Non-use of a trademark as a basis for termination of its legal protection is present in the legislation of almost all countries of the European Union. Thus, in the Czech Republic, the patent department eliminates a trademark from the register if the trademark has not been used in the Czech Republic, at least within 5 years before the initiation of the procedure of elimination, and the owner of the trademark was not provided with significant reasons for its non-use. Most of the trademark laws of the European Union countries adhere to the Czech law, the five years of non-use of the trademark<sup>5</sup>. The five-year term of non-use of a trademark was previously established by the Law of the Republic of Uzbekistan "On Trademarks" before the amendments made by No. 267-II of August 30, 2001, and then by the Civil Code of the Republic of Uzbekistan, which established such a period of 3 years.

At the same time, the determination of the calculation of the five-year period of non-use of the trademark in the legislation of the countries of the European Union is interpreted for domesticated. In Finland, the termination of legal protection of a trademark cannot be claimed if the trademark was used after a five-year period of non-use, but before the filing of a request to declare its registration invalid. In this case, any use of a trademark that takes place within 3 months prior to the filing of a request for cancellation of its registration will not be considered if the preparation for use began only after the trademark owner realized the possibility of filing a request for cancellation of trademark registration<sup>6</sup>.

It should be noted that in some countries of the European Union, trademark laws provide for certain exceptions under which the legal protection of a trademark cannot be terminated due to non-use. In Italy, the termination of legal protection of a trademark due to non-use does not apply if the owner of the unused trademark is simultaneously the owner of one or more similar marks that are still in force and of which at least one is used to distinguish the same goods or services<sup>7</sup>. This is done in order to ensure that the trademark, which expires, is not registered immediately after the end of its registration in the name of another holder. Thus, there may be a situation of registration of two similar trademarks used to label the same goods or services, in the name of different holders. The ultimate goal of this rule is to protect the rights of consumers in order to prevent the possibility of misleading them about the quality of the product and its manufacturer.

The possibility of termination of the legal protection of a trademark in the event of a request for this by the trademark owner is present in almost all trademark laws of the countries of the European Union. So, in Denmark, during the period of validity of the registration of a trademark, in accordance with the request of the right holder, the trademark can be removed from the register<sup>8</sup>. However, as a rule, the laws on trademarks provide exceptions for which the legal protection of the trademark on this basis cannot be terminated. In the legislation of Finland, the impossibility of excluding a trademark from the registry on the application of the right holder without the consent of

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<sup>5</sup> Czech Republic, Law on Trademarks (Article 24 (1) (№137 of June 21,1995)// Industrial Property and Copyright. -1996. -4.-3-001.

<sup>6</sup> Finland, Trademarks Act №7 on January 10,1964 (Article 26) (as amended by Act №1715 of December 22,1995//Intellectual Property Laws and Treaties. -1998/4.-3-002.

<sup>7</sup> Italy, Trademark Law, Royal Decree №929 of June 21,1942 (Article 42 (4) (as last amended by Legislative Decree №198 of March 19,1996)//Industrial Property and Copyright.-1997/1.-3.-001.

<sup>8</sup> Denmark, The Trade Marks Act, Consolidated Act №162 of February 21, 1997 (Article 33) // Industrial Property and Copyright. -1998/5.-3-001.

the pledgee, if this trademark was pledged<sup>9</sup>. In the Czech Republic, such a statement of the right holder will not have legal force if there are third-party rights<sup>10</sup>.

The termination of the legal protection of a trademark is possible if the registered trademark has turned into a designation that has come into general use as a designation for goods of a certain type. Such a basis is contained in many laws on trademarks of the countries of the European Union. In Denmark, the legal protection of the trademark may be discontinued if the trademark is included in the actions or idleness of the owner of the trademark as a product or service name for which it was registered<sup>11</sup>. Similarly, this basis is interpreted in the law of Ireland about trademarks, when the logging of a trademark may be canceled if the owner's actions or inaction of the owner, the trademark has become a generally accepted name in trade for the goods or services for which it has been registered<sup>12</sup>.

In the legislation of the countries of the European Union, some reasons are provided for the termination of the legal protection of the trademark, which are not fixed in direct form in the Civil Code of the Republic of Uzbekistan. Thus, the trademark laws of most countries of the European Union provide that the legal protection of a trademark may be terminated if, as a result of the use of the trademark by the holder or with his consent in relation to the goods or services for which it was registered, this use may mislead about the nature, quality or geographical origin of the goods or services. For example, in Italy, a trademark is canceled if, due to the type and context of its use by the owner or with his consent to the goods or services for which he is registered, there is a possibility of misleading the consumer in the process of using the mark, in particular with respect to the nature, quality or geographical origin of goods or services<sup>13</sup>. Also, in the legislation of Italy, a peculiar foundation is provided for the termination of the legal protection of the trademark. A trademark can be revoked if it begins to conflict with public policy, law or accepted moral principles.

As a rule, in the laws on trademarks of the countries of the European Union, conditions are contained under which the recognition of the invalidity of a trademark will not have legal force. The Spanish Trademark Law provides as such a condition that the recognition of the invalidity of a trademark has no legal force for: court decisions that entered into force prior to the declaration of the trademark in respect of trademark infringements; contracts concluded before the declaration of the trademark as invalid to the extent that they entered into force before the declaration of the trademark as invalid<sup>14</sup>.

In general, it should be noted that the main issues related to the termination of the legal protection of trademarks on the legislation of the European Union countries. Termination of the legal protection of a trademark is possible, both in the event of the occurrence of a particular legal fact, and as a result of a protest against the very fact of registration of a trademark. An analysis of the

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<sup>9</sup> Finland, Trademarks Act №7 on January 10,1964 (Article 24) (as amended by Act №1715 of December 22,1995//Intellectual Property Laws and Treaties. -1998/4.-3-002.

<sup>10</sup> Czech Republic, Law on Trademarks (Article 24) (№137 of June 21,1995)// Industrial Property and Copyright.-1996.-4.-3-001.

<sup>11</sup> Denmark, The Trade Marks Act, Consolidated Act (Article 24 (2) №162 of February 21, 1997// Industrial Property and Copyright. -1998/5.-3-001.

<sup>12</sup> Ireland Trade Marks Act 1996 (Article 51) (Act No. 6 of 1996). wipolex.wipo.int/en/legislation/details/2332

<sup>13</sup> Italy, Trademark Law, Royal Decree №929 of June 21,1942 (Article 41) (as last amended by Legislative Decree №198 of March 19,1996)//Industrial Property and Copyright. -1997/1.-3.-001.

<sup>14</sup> Law No. 32/1988 of November 10, 1988 on Trademarks of Spain (Article 51) (as amended by Law 14/1999 of May 4, 1999)

legislation of the European Union indicates the presence of absolute and relative grounds for recognizing the invalidity of the trademark. The legislation of the European Union refers to the absolute grounds for invalidating a trademark: registration of a trademark in the presence of absolute grounds for refusal to register and the applicant's bad faith when filing an application for registration, to relative grounds - the presence of an earlier trademark or an earlier right to a trademark, as well as the registration of a trademark, despite the existence of relative grounds for refusing such registration<sup>15</sup>. The results of the study showed that most of the grounds for termination of legal protection of trademarks in Uzbekistan and the countries of the European Union coincide. At the same time, in the European Union itself, the grounds and procedure for revoking trademark registration are often interpreted differently in different countries. If in most countries of the European Union the cancellation of the registration of a trademark on the basis of its non-use is carried out in court (for example, in Italy and France), then in a number of others (for example, in the UK) this procedure is carried out administratively with the possibility of appeal by the trademark owner of this decision in court. Denmark's legislation allows the cancellation of a trademark registration and by the court decision, and administratively.

An analysis of the legislation of European countries allowed us to identify the presence of certain grounds in the legislations of the European Union to terminate the legal sign of the trademark, which are not enshrined in direct form in the Civil Code of the Republic of Uzbekistan. In particular, the trademark laws of most countries of the European Union determine the possibility of termination of legal protection of a trademark if, as a result of the use of the trademark by the right holder or with his consent in relation to the goods or services for which it was registered, this use may mislead about the nature, quality or geographical origin of goods or services.

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<sup>15</sup> Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark (Article 51 and 52) (amended in accordance with Council of the European Union Regulation No. 3288/94 of December 22, 1994)

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